

**REMARKS**

Claims 1-22 are pending in the application.

Claims 1-22 have been rejected.

Claims 1 and 12 have been amended as set forth herein.

Claims 1-22 remain pending in this application.

Reconsideration of the claims is respectfully requested.

**I. CLAIM REJECTION UNDER 35 U.S.C. § 103**

Claims 1, 3-12, and 14-22 were rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent Publication No. 2002/0057657 to *La Porta, et al.*, hereinafter “La Porta” in view of U.S. Patent Publication No. 2004/0005884 to *Nieminen et al.*, hereinafter “Nieminen” and further in view of U.S. Patent No. 6,580,699 to *Manning et al.*, hereinafter “Manning”. The Applicant respectfully traverses the rejection.

Claims 2 and 13 were rejected under 35 U.S.C. § 103(a) as being unpatentable over La Porta reference in view of Nieminen reference and Manning reference as applied to claims 1 and 12 above, and further in view of U.S. Patent No. 6,999,766 to *Padovani*, hereinafter “Padovani”. The Applicant respectfully traverses the rejection.

In ex parte examination of patent applications, the Patent Office bears the burden of establishing a prima facie case of obviousness. MPEP § 2142; *In re Fritch*, 972 F.2d 1260, 1262, 23 U.S.P.Q.2d 1780, 1783 (Fed. Cir. 1992). The initial burden of establishing a prima facie basis to

deny patentability to a claimed invention is always upon the Patent Office. MPEP § 2142; In re Oetiker, 977 F.2d 1443, 1445, 24 U.S.P.Q.2d 1443, 1444 (Fed. Cir. 1992); In re Piasecki, 745 F.2d 1468, 1472, 223 U.S.P.Q. 785, 788 (Fed. Cir. 1984). Only when a prima facie case of obviousness is established does the burden shift to the applicant to produce evidence of nonobviousness. MPEP § 2142; In re Oetiker, 977 F.2d 1443, 1445, 24 U.S.P.Q.2d 1443, 1444 (Fed. Cir. 1992); In re Rijckaert, 9 F.3d 1531, 1532, 28 U.S.P.Q.2d 1955, 1956 (Fed. Cir. 1993). If the Patent Office does not produce a prima facie case of unpatentability, then without more the applicant is entitled to grant of a patent. In re Oetiker, 977 F.2d 1443, 1445, 24 U.S.P.Q.2d 1443, 1444 (Fed. Cir. 1992); In re Grabiak, 769 F.2d 729, 733, 226 U.S.P.Q. 870, 873 (Fed. Cir. 1985).

A prima facie case of obviousness is established when the teachings of the prior art itself suggest the claimed subject matter to a person of ordinary skill in the art. In re Bell, 991 F.2d 781, 783, 26 U.S.P.Q.2d 1529, 1531 (Fed. Cir. 1993). To establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed invention and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. MPEP § 2142.

Amended Claim 1 comprises unique and novel elements, including those emphasized below:

1. A wireless network capable of providing a MS-MS packet data call between a source mobile station (MS) and a destination mobile station (MS), said wireless network comprising:
  - a first base station capable of wirelessly communicating with said source mobile station;
  - a second base station capable of wirelessly communicating with said destination mobile station;
  - a mobile switching center capable of connecting said first and second base stations wherein the mobile switching center is capable of sending an assignment request, *wherein the mobile switching center authenticates both the source and the destination mobile station are authorized to use both the packet call data service and the wireless network and wherein the assignment request comprises at least one mobile identifier*; and
  - a local Internet protocol (IP) network capable of transferring data packets associated with said MS-MS packet data call directly between said first and second base stations via a first packet data bearer connection, wherein said first base station is capable of receiving a first message from said source mobile station indicating that said source mobile station is to be handed off to a third base station, and wherein said first base station, in response to said first message, initiates establishment of a second packet data bearer connection on said local IP network for transferring said data packets associated with said MS-MS packet data call directly between said second and third base stations. [Emphasis Added]

Claim 1 comprises the element, "*wherein the mobile switching center authenticates both the source and the destination mobile station are authorized to use both the packet call data service and the wireless network*". Therefore, the mobile switching center provides authentication for both the wireless network and the packet call data service. It is respectfully submitted that none of the prior art of record teaches, suggests, or anticipates this element. This element is fully supported by the

original specification, as filed, including the following paragraph:

MSC 140 authenticates both MS 111 and MS 113 to verify that both devices are permitted to access wireless network 100. MS 140 also verifies that MS 111 and MS 113 are both authorized to use the MS-MS packet data call service. MSC 140 finds MS 113 in the service area and sends Paging Request message 203 to BS 102, which is the last base station on which MS 113 registered. In response, BS 102 transmits Page message 204 to MS 113 with an indication (SO) of an incoming packet data call. MS 113 transmits Response message 205 indicating MS 113 will accept the packet data call. (Paragraph [040], original specification)

Therefore, Applicant respectfully submits that the prior art of record does not teach, suggest, or anticipate the elements of Claim 1.

Claim 12 has been similarly amended, and therefore is also patentable over the prior art of record.

In addition, the Applicant respectfully submits that neither *La Porta* nor *Nieminen*, either alone or in combination, discloses, teaches or suggests “a local Internet protocol (IP) network capable of transferring data packets associated with said MS-MS packet data call directly between said first and second base stations via a first packet data bearer connection, wherein said first base station is capable of receiving a first message from said source mobile station indicating that said source mobile station is to be handed off to a third base station, and wherein said first base station, in response to said first message, initiates establishment of a second packet data bearer connection on said local IP network for transferring said data packets associated with said MS-MS packet data call directly between said second and third base stations,” as recited by independent Claim 1.

As discussed in paragraph [042] of the specification, as filed, this connection relates to a connection made between the first base station and the second base station. This connection, between base stations, is not taught or suggested by the prior art of record. In fact, the prior art is directed at using a connection routed either through a mobile station or through a PDSN, not directly from a first base station to a second base station. None of the prior art of record teaches a direct connection between a first and second base station through a packet data bearer connection.

In addition, the Examiner attempts to cure the deficiency of the prior art in reference to the “assignment request” by pointing to Manning. As previously explained, the assignment request may comprise an IP address and a mobile identifier. This two-part identification is not taught by the prior art of record. La Porta only discusses a mobile IP, and Niemaen does not cure this deficiency. Manning does not cure this deficiency, as it only asserts that an assignment request may be present, but fails to show that the assignment comprises both an IP address and a mobile identifier. Figure 6 cited by the examiner fails to show this two-part identification. In response the Examiner statement on Page 11 of the Final Office Action, Applicant has clarified Claim 1 to include, "and wherein the assignment request comprises at least one mobile identifier". It is therefore respectfully submitted that none of the cited art of record teaches or suggests sending an assignment request.

Similar to independent Claim 1, independent Claim 12 recites “in response to the first message, initiating establishment of a second packet data bearer connection on the local IP network for transferring the data packets associated with the MS-MS packet data call directly between the second and third base stations.” Accordingly, for the reasons discussed above in connection with

Claim 1, independent Claim 12 is not made obvious by the cited art. Therefore, the Applicant respectfully submits that this rejection should now be withdrawn.

Dependent Claims 2-11, which depend from independent Claim 1, and dependent Claims 13-22, which depend from independent Claim 12, are also not made obvious by the cited art because they include the limitations of their respective base claims and add additional elements that further distinguish the art. Therefore, the Applicant respectfully submits that these rejections should now be withdrawn.

Accordingly, the Applicant respectfully requests the Examiner to withdraw the § 103 rejection with respect to these claims.

The Applicant also disagrees with the Examiner's rejections of Claims 1-22 based on additional misdescriptions and/or misapplications of *La Porta*, *Nieminen* and *Manning* to at least some of Claims 1-22. However, the Applicant's arguments regarding those other shortcomings of *La Porta*, *Nieminen* and *Manning* are moot in view of the Claim 1 arguments above. However, the Applicant reserves the right to dispute in future Office Action responses the appropriateness and the applications of *La Porta*, *Nieminen* and *Manning* to the claims of the present application, including the right to dispute assertions made by the Examiner in the January 21, 2009 Office Action.

**CONCLUSION**

As a result of the foregoing, the Applicant asserts that the remaining claims in the Application are in condition for allowance, and respectfully requests that this Application be passed to issue.

If any issues arise, or if the Examiner has any suggestions for expediting allowance of this Application, the Applicant respectfully invites the Examiner to contact the undersigned at the telephone number indicated below or at *[jmockler@munckcarter.com](mailto:jmockler@munckcarter.com)*.

The Commissioner is hereby authorized to charge any additional fees connected with this communication or credit any overpayment to Deposit Account No. 50-0208.

Respectfully submitted,

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